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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,667	10/24/2003	Jeffrey Dean Black	600189.432	9634
61834	7590	12/21/2006		
DREIER LLP 499 PARK AVE NEW YORK, NY 10022			EXAMINER CHEN, TE Y	
			ART UNIT 2161	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	12/21/2006	PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/693,667	Applicant(s) BLACK ET AL.	
	Examiner Susan Y. Chen	Art Unit 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-21 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/10/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

This office action is in response to the amendment filed on examination October 10, 2006.

Claims 4-21 are pending for examination, claims 1-3 have been canceled, claims 4 and 8-10 have been amended.

Terminal Disclaimer

The terminal disclaimer filed on October 10, 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6,735,585 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 14 is rejected under the judicially created doctrine of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,654,813. Although the conflicting claims are not identical, they are not patentably distinct from each other. To facilitate the comparing of these two claims, the recitation of these claims are listed as following:

Instant Application	U.S. Patent No. '813	
<p>Claim 14:</p> <p>A method for providing a user with at least one response to a search query of the Internet, the method comprising:</p> <p>receiving a search query from a user in the form of category selection;</p>	<p>Claim 1:</p> <p>A method of operating a search engine, comprising:</p> <p>acquiring from a user of the search engine a search request, the search request including a set of</p>	

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<p>determining at least one entity associated with the search query;</p> <p>determining at least one URL under the control of the entity; and</p> <p>displaying the URL to the user.</p>	<p>criteria that defines a category of entities;</p> <p>dynamically applying the set of criteria to identify an entity that meets the criteria;</p> <p>determining that the entity is registered as having control over at least a portion of a World-Wide Web address; and</p> <p>associating the at least a portion of a World-Wide Web address with the entity</p> <p>in a presentation to a user of the search engine that identifies the entity and indicates that the entity belongs to the category of entities.</p>	
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Because claim 1 of U.S. Patent No. '813 contains every element of claim 1 of the instant application and thus anticipates the claim of instant application. Claim 1 of the instant application therefore is not patentably distinct from the earlier patented claims and as such is unpatentable over obvious-type double patenting. A later patent/application claim is not patentably distinct from earlier claims if the later claim is anticipated by the at least one of earlier claims.

Information Disclosure Statement

The information disclosure statement filed on Oct. 10, 2006, has been acknowledged and placed in the application file.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 4, 6, 8, 10-11, 13-14 and 16-21, are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,958,008 issued to Pogrebisky et al. (hereinafter referred as Pogrebisky).

Claim 4:

Pogrebisky discloses a system for providing a user with at least one response to a search query of the Internet [e.g., Abstract, the Astra system as shown in Fig(s) 1, 19-20, etc.], the system comprising:

- a user interface, the user interface effective to receive a search query from a user [e.g., col. 2, lines 18-23];

- a web page record database connected to the user interface, the web page record database including a plurality of web page records, the plurality of web page records including a response to the search query [e.g., col. 3, lines 31-43, Fig. 4 and associated texts];

- a search engine module connected to both the user interface and the web page record database, the search engine module effective to search the web page record database for the response [e.g., the use of Webcrawling, Common Gateway Interface and Internet/Intranet techniques at col. 7, lines 9 –16 & 23-31& Fig(s) 7, 13-15];

- an entity information database including information about entities that control one-or more web page records [e.g., the "URL" of each content object in the Web site database, col. 5, lines 66 – col. 6, line 30, the Common Gateway Interface(CGI) at col. 7, lines 23-32]; and

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a mapping database connected to the web page record database and the entity information database, the mapping database including information for mapping the records with respective entities [e.g., the Web site map, col. 7, lines 54–67; Fig. 1 and associated texts].

Claim 6:

In addition to the limitations recited in claim 4, Pogrebisky further discloses that the entity information database includes geographic information about the entities [e.g., Abstract, lines 4-6; Fig. 4 and associated texts].

Claim 8:

In addition to the limitations recited in claim 4, Pogrebisky further discloses that the mapping database maps a particular entity to a plurality of records.

Claim 10:

Pogrebisky discloses a method for providing a user at least one response to a search query of the Internet [e.g., Fig. 1 and associated texts], the method comprising: receiving a search query from a user [e.g., col. 2, lines 18-23];

searching a web page record database for a response to the search query [e.g., e.g., the use of Webcrawling at col. 7, lines 9-16; Fig(s) 13-15];

mapping the response to an entity associated with the response, wherein the entity controls one or more web page records [e.g., the use of "URL" of each content

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object in the Web site database, col. 5, lines 66 – col. 6, line 30, the use of Common Gateway Interface(CGI) at col. 7, lines 23-32, the use of Web site map at col. 7, lines 54–67, Fig(s). 1-3 and associated texts]; and

displaying the response and a name of the entity to the user [col. 15, lines 27-44; Fig.(s) 1 and 4-6].

Claim 11:

In addition to the limitations recited in claim 10, Pogrebisky further discloses that the search query is based on a hierarchical category structure [e.g. col. 2, lines 27-48; Fig. 6].

Claim 13:

In addition to the limitations recited in claim 10, Pogrebisky further discloses that the method comprising displaying geographic information about the entity [e.g., Abstract, lines 4-6; Fig. 4 and associated texts].

Claim 14:

Pogrebisky discloses a method for providing a user with at least one response to a search query of the Internet [e.g., Abstract, Fig. 1], the method comprising: receiving a search query from a user in the form of category selection [e.g., the use of user interface at col. 2, lines 18-23];

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determining at least one entity associated with the search query [the creation of Web site map by the Astra GUI navigation tools , col. 9, lines 60 – col. 10, line 67; Fig. 1 and associated texts];

determining at least one URL under the control of the entity [e.g., the use of URL technique at col. 10, lines 7-30 and Fig. 3];

displaying the URL to the user [e.g., the use of Visual Web Display technique at col. 10, lines 54-57; Fig(s) 1-3].

Claim 16:

In addition to the limitations recited in claim 14, Pogrebisky further discloses that the category selection comes from a hierarchical category structure [e.g. col. 2, lines 27-48; Fig. 6].

Claim 17:

In addition to the limitations recited in claim 14, Pogrebisky further discloses that the search query includes geographic criteria and the method further comprises filtering the at least one URL based on the geographic criteria before performing the displaying [e.g., the filtering bar (47, Fig. 1) at col. 16, line 8-26 & col. 26, VIII section].

Claim 18:

In addition to the limitations recited in claim 14, Pogrebisky further discloses that the geographic criteria is a city [e.g., col. 19, lines 29-33].

Claim 19:

In addition to the limitations recited in claim 14, Pogrebisky further discloses the at least one URL includes a plurality of URLs and the plurality of URLs are displayed to the user in an order of popularity [col. 3, lines 9-30].

Claim 20:

In addition to the limitations recited in claim 14, Pogrebisky further discloses displaying a name of the entity [e.g., Fig. 4 and associated texts].

Claim 21:

In addition to the limitations recited in claim 14, Pogrebisky further discloses displaying a plurality of URLs and the method further comprises enabling the user to execute a search in only the plurality of URLs [e.g., the use of clicks on URL icon, at col. 10, lines 20-30 and Fig. 3].

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 7, 9, 12 and 15, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,958,008 issued to Pogrebisky et al. in view of Applicant Admitted Prior Art (AAPA), as applied to claim 1 above, and further in view of U.S. Patent No. 6,151,624, issued to Teare et al. (herein after referred as Teare).

Claim 5:

In addition to the limitations recited in claim 4, Pogrebisky does not specifically disclose that the mapping database uses American Business Information Numbers. However, as admitted by Applicant's specification that the American Business Information Numbers is sponsored by info USA [e.g., Page 6, line 3], thus, it would have been obvious for an ordinary skilled person in the art at the time the invention was made to apply the widely used existing American Business Information Numbers into the claimed mapping database, because by doing so, the claimed database will be allowed

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to map the unique American Business Information Numbers to any American business without reinventing the wheel.

Claim 7:

In addition to the limitations recited in claim 4, Pogrebisky does not specifically disclose that the entity information database uses Standard Industry Code (SIC) fields. However, as admitted by Applicant's specification that the claimed Industry Code is a Standard. Therefore, it would have been obvious for an ordinary skilled person in the art at the time the invention was made to apply the well-known SIC field in the claimed database, because by doing so, the claimed database will be upgraded to apply the SIC field for classifying the industry and still binding to the desired standard.

Claim 9:

In addition to the limitations recited in claim 4, Pogrebisky does not specifically disclose that the entity information database includes one or more companies and their financial profile information.

However, Teare discloses the entity information database includes one or more companies and their financial profile information [e.g., Abstract, Fig. 7A and associated texts].

Pogrebisky and Teare are both in the same endeavor to optimize Web page query processing via Internet databases, as such, it would have been obvious for an ordinary skilled person in the art at the time the invention was made to include the

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claimed one of more companies and their financial profile information as the entities of the well-known Web-site database, because by doing so, the claimed entity database will be promoted to support the manipulation of global business and financial entities as desired by users.

Claim 12:

This claim recites similar subject matters as claim 5 in form of method, hence, is rejected for the same reason.

Claim 15:

This claim recites similar subject matters as claim 7 in form of method, hence, is rejected for the same reason.

Response to Arguments

Applicant's arguments filed on Oct. 10, 2006, have been fully considered but they are not persuasive.

The examiner disagrees with Applicant's arguments against Double Patenting rejection. The current filing of terminal disclaimer merely overcome the Double Patenting rejection against '585 patent, it does not overcome the Double Patenting rejection of '813. i.e., If multiple conflicting patents and/or pending applications are applied in double patenting rejections made in a single application, then prior to issuance of that application, it is necessary to disclaim the terminal part of any patent

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granted on the application which would extend beyond the application date of each one of the conflicting patents and/or applications. Each one of the commonly owned conflicting double patenting references must be included in the terminal disclaimer to avoid the problem of dual ownership of patents to patentably indistinct inventions in the event that the patent issuing from the application being examined ceases to be commonly owned with any one of the double patenting references that have issued or may issue as a patent.

The examiner further disagrees with applicant's arguments and piecemeal interpretations that are summarized as following:

- 1) Pogrebisky does not disclose a system comprising, an entity information database including information about entities that control one or more web page records;
- 2) Pogrebisky does not disclose a mapping database including information for mapping the web page records with respective entities;
- 3) Pogrebisky does not disclose determining at least one entity associated with the search query and determining at least one URL under the control of the entity.

In reply to arguments 1), the examiner directs applicant's attention to each of the record of web site databases as shown in Fig. 4 and described by Pogrebisky as followings:

"web site" refers generally to a database or other collection of inter-linked hypertextual documents ("web

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documents") and associated data entities, which is accessible via a computer network, and which forms part of a larger, distributed informational system." (col. 5, line 66 - col. 6, line 3)

Here, each web site record reads the claimed entity information database that including information about entities to control one or more web page records such as the URLs, the distribution protocols, etc., which can be used by the network distribution informational system [e.g., the Common Gateway Interface(CGI) at col. 7, lines 23-32] to control the distribution of one or more web page records.

In reply to arguments 2), the examiner points out that the created Web site map by Astra software package as depicted by Pogrebisky as followings:

"Given the address of a Web site's home page, Astra automatically scans the Web site and creates a graphical site map showing all of the URLs of the site and the links between these URLs. In accordance with one aspect of the invention, the layout and display method used by Astra for generating the site map provides a highly intuitive, graphical representation which allows the user to visualize the layout of the site." (col. 7, lines 54-47)

In reply to arguments 3), the examiner further points out that Pogrebisky specifically disclosed the claimed features as followings:

"Maps of the type illustrated in FIG. 1 are generated by Astra using an HTTP-level scanning process (described below) which involves the reading and parsing the Web site's HTML pages to identify the architecture (i.e., the arrangement of URLs and links) of the Web site, and to obtain various status information (described below) about the Web site's URLs. The basic scanning process used for this purpose is generally similar to the scanning process used by conventional Webcrawlers. As part of Astra's Dynamic Scan feature, Astra

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additionally implements a special dynamic page scanning process which permits dynamically-generated Web pages to be scanned and included in the Web site map. As described below, this process involves capturing the output of a Web browser when the user submits an HTML-embedded form (such as when the user submits a database query), and then reusing the captured dataset during the scanning process to recreate the form submission and append the results to the map." (col. 9, lines 16-33)

Here, contrary to applicant's arguments, Pograbsky clearly cited that using the dynamic Astra software to determine the creation and recreation of the claimed URL and associated information entries based on user's database queries and under the control of the entities navigation.

As to the rest of arguments, applicant merely rehashes issues already addressed on record, thus, based on the discussion above, the rejections are maintained.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Points of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Y. Chen whose telephone number is 571-272-4016. The examiner can normally be reached on Monday - Friday from 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Susan Y Chen
Examiner
Art Unit 2161

December 12, 2006

E P Chen
primary examiner